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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,308	12/22/2000	Eric G. Jakstadt	MSI-428US	2673
22801	7590	07/07/2004	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/747,308

Applicant(s)

JAKSTADT ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 19-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 19-28, drawn to an electronic bill payment system, classified in class 705, subclass 40.
- II. Claims 10-18, drawn to a method for developing content of an on-line system, classified in class 705, subclass 35.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, group II may be used to develop on-line content, such as designing any web page.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Dave Morasch on June 24, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-9 and 19-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-18 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 22 are rejected for the following reasons:

In claim 1, "UI" has not been positively recited in body of the claim, and, therefore, lacks antecedent basis.

In claim 6, "server" has not been positively recited in the body of the claim, and, therefore, lacks antecedent basis.

In claim 22, "production space" lacks antecedent basis.

Claims 2-5 and 7-8 are rejected for their dependency upon a rejected claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9 and 19-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hilt (6,408,284).

Hilt discloses an electronic bill pay system and corresponding method for consumers comprising a first component, hosted by a financial service center, to navigate the UI and invoke one or more functions of the financial service center and a second component, hosted by a third-party, to provide detailed billing information from a biller to the user (col.12, line 48 to col.13, line 23; col.17, lines 28-55; and fig.4-all); the second component is only provided to the user upon verification of user authorization to receive the detailed billing information (col.19, line 64 to col.20, line 45 and fig.10-all); the first component provides summary billing information (col.20, lines 45-68 and fig.11-all); the financial service center receives batch bill information along with authentication strings from the biller (col.17, lines 28-54 and col.18, line 38 to col.19, line 55 and fig.9-all); the authentication strings are sent to the third-party to authorize delivery of the second component (col.17, lines 28-54 and col.18, line 38 to col.19, line 55 and fig.9-all); each of the financial service center and the third-party independently create the billing statement on the server (col.17, lines 28-54 and col.18, line 38 to col.19, line 55

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and fig.9-all); the billing statement is comprised of a plurality of executable instructions sent from the financial service center and the third-party for rendering in a browser executing on a user computing system (col.17, line 28 to col.18, line 10); a storage medium comprising a plurality of executable instructions which, when executed, render a billing statement according to the above claim (col.12, line 48 to col.13, line 23; col.17, lines 28-55; and fig.4-all); a financial service center, providing a common network address where consumers can review and pay bills from a number of billers, to host at least a subset of a billing statement for review by a requesting user and a third-party server, coupled to the financial service center, to provide bill summary information to the financial service center, which securely and imperceptibly redirects the user to the third-party server which hosts at least a subset of the billing statement comprising detailed billing information (col.12, line 48 to col.13, line 23; col.17, lines 28-55; and fig.4-all); one or more servers, coupled to a data network, through which billers and consumers access the EBPP system and a secure third-party development platform, wherein registered developers can develop content for publication via the EBPP system upon validation (col.12, line 48 to col.13, line 23; col.17, lines 28-55; and fig.4-all); the secure third party development platform comprises a development server, wherein authorized third-party content developers can remotely develop and debug content for subsequent posting to users through the one or more servers and a validation agent, responsive to the development server, to automatically test and certify that the third-party content developed on the development server is robust and will not harm production servers (col.18, line 38 to col.19, line 55); a production server, to receive validated third-party

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content and simulation agent, to automatically perform load testing on the validated third-party content (col.18, line 38 to col.19, line 55); content that passes load testing is promoted from the production space to the one or more servers for access and use by consumers and billers (col.18, line 38 to col.19, line 55); a method of validating a third-party developed content for publication through an electronic bill presentment and payment system, the method comprising receiving third-party developed content, reading the received third-party developed content, reviewing the content to identify logical, syntactical or security errors, and promoting only that content for which no errors are identified for publication on one or more servers comprising the EBPP system (col.12, line 48 to col.13, line 23; col.17, lines 28-55; col.18, line 38 to col.19, line 55; and fig.4-all); posting validated third-party content to a production server and simulating consumer load on the validated third-party content to ensure that the content will perform under load (col.18, line 38 to col.19, line 55); posting third-party content from the production server to one or more web servers providing a consumer interface to the EBPP system upon verification that the content will perform under consumer load (col.18, line 38 to col.19, line 55); issuing instructions to a requesting user to render a billing statement, wherein the billing statement reflects the third-party content, while one section of the billing statement is hosted by the web servers, while another section of the billing statement is hosted by a third-party server (col.12, line 48 to col.13, line 23; col.17, lines 28-55; col.18, line 38 to col.19, line 55; and fig.4-all); the third-party server is hosted by the biller (col.18, line 38 to col.19, line 55); and issuing instructions to a requesting user to render a billing statement, wherein the billing statement reflects the

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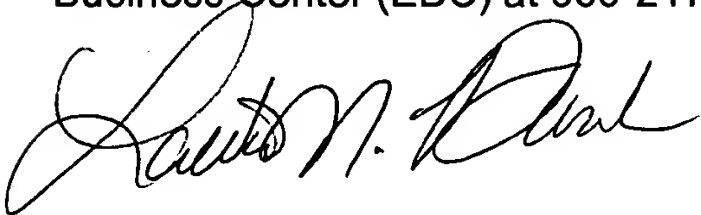
third-party content, while one section of the billing statement is hosted by the web servers, while another section of the billing statement is hosted by a third-party server (col.18, line 38 to col.19, line 55).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH

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